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08/999,308	12/29/97	FUJINO	N FUJ014691

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EMPIRE STATE BUILDING  
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NEW YORK NY 10118-0110

EXAMINER

ENG, G

ART UNIT

PAPER NUMBER

2743

DATE MAILED:

03/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/999,308

Applicant(s)

Fujino et al.

Examiner

George Eng

Group Art Unit  
2743



☒ Responsive to communication(s) filed on Jan 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 and 9-14 is/are rejected.

☒ Claim(s) 7, 8, and 15 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the Amendment filed 12/16/1999 (paper no. 7).

### *Claim Rejections - 35 U.S.C. § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US PAT. 5,841,840 hereinafter Smith).

Regarding claim 1, Smith discloses a communication system as shown in figure 2 comprising a server (i.e., 10) providing information, a terminal (i.e., 30 and 33) communicating with the server, and a communication network 20, wherein a temporary line disconnection unit, i.e., a controller 34, for disconnecting a line being used for data communication without issuing any disconnection notifications of the terminal when a third party other than the server is being

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voice communicated during a data communication between the terminal and the server (col. 3 line 49 through col. 5 line 25).

Regarding claim 2, Smith teaches the terminal obtaining a telephone number of the third party as information during the data communications (col. 4 lines 7-9).

Regarding claims 3-5, Smith teaches the server comprising a telephone switch unit (col. 3 lines 55-57) and the temporary line disconnecting unit provided in the terminal and the server for disconnecting the line 17 between the terminal and the server when the terminal issues a request for voice communication with the third party (col. 4 line 45 through col. 5 line 25).

Regarding claim 6, Smith discloses a first unit for managing communication status (col. 5 lines 15-24).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 3-4.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

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*Claim Rejections - 35 U.S.C. § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al. (US PAT. 4,995,074 hereinafter Goldman) in view of O'Horo et al. (US PAT. 5,519,767 hereinafter O'Horo).

Regarding claim 1, Goldman discloses a communication system as shown in figure 1 comprising a server (i.e., a host computer 16), a terminal 14 for communicating data with the server, a communication network 12, and an interface (i.e., 28) for disconnecting a line being used for data communication without issuing any disconnection notifications of the terminal when a

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third party other than the server is being voice communicated during a data communication between the terminal and the server (col. 4 lines 31-61 and col. 5 lines 4-11). Goldman differs from the claimed invention in not specifically teaching the interface in respond to a specified data from the server and the terminal for disconnecting a line being used for data communication. However, O'Horo teaches such (col. 1 line 60 through col. 2 line 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the communication system of Goldman, as per teaching of O'Horo because it improves the communication of Goldman so that a called party is given a chance to put a fist call on hold and answer a second call.

Regarding claim 2, O'Horo discloses the terminal obtaining a message of the third party during the data communication (col. 4 lines 12-27).

Regarding claims 3-4, Goldman teaches the server comprising a telephone switch means and an interface (i.e., 34) for temporarily disconnecting a line between the server and the terminal when a voice communication to the third party is issued (col. 4 line 62 through col. 5 line 11).

Regarding claim 5, O'Horo discloses to disconnect the present call on a terminal side when a request for voice communication with the third party (col. 4 lines 36-48).

Regarding claim 6, Goldman teaches the interface comprising a first means for managing communication status (col. 5 line 49 through col. 6 line 2).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

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Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 3-4.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

#### *Allowable Subject Matter*

6. Claims 7-8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ishibashi et al. (US PAT. 5,333,134) discloses a connection hold control system adapted to a data communication system (col. 3 line 58 through col. 6 line 20).

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**

(703) 308-6296 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

GEORGE ENG

February 15, 2000

  
CURTIS A. KUNTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2700